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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 17

Application Number: 09/402,563
Filing Date: 10/5/99
Appellant(s): VAN ROMUNDE, ET AL

MAILED

~~DEC 15 2003~~
3/18/2004

GROUP 3600

Maria Parrish Tungol
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/24/03

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal

is contained in the brief.

(3)   *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4)   *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   *Summary of Invention*

The summary of invention contained in the brief is correct.

(6)   *Issues*

The appellant's statement of the issues in the brief is correct.

(7)   *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3, 5-14, 16 and 17 do not

stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and

(c)(8).

Appellant groups the claims as follows:

Group 1: Claims 1, 5-10, 12, 16 and 17

Group 2: Claims 2-3 and 13-14

Group 3: Claim 11

(8)   ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   ***Prior Art of Record***

5,583,758   MCllroy   12-1996

(10)   ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

5.   Claims 1, 2,11 are rejected under 35 U.S.C. 102(b) as being anticipated by

Mcllroy et al (US Patent 5,583,758).

As per claim 1, Mcllroy, et al discloses:

Method for electronically storing, retrieving and/or modifying records using a

computer system, (Col. 2, lines 42-47. Col. 11, lines 52-64, where displaying of the file

on the screen constitutes the storage of the file or record);

comprising a display unit, (Col. 4, line 54);

an input unit, (Col. 4, line 52);

a memory unit, (Col. 4, line 52);

and a processing unit, (Col. 4, line 52);

and involving at least one recorded catalogue of recommended actions, (Col. 7,

lines 45-53, Col. 5, lines 21-45);

and for sequentially steering a process of interrelated actions from said at least

one recorded catalogue of recommended actions, (Col. 7, line 54-Col. 8, line 22, Col. 2,

line 59-Col. 3, line 3);

wherein at least on recorded catalogue of recommended action comprises

hierarchised sequences of alternative actions, (Col. 2, lines 66-Col. 3, line 4 [options],

Col. 5, lines 14-20);

wherein said actions comprise sequential procedure steps, (Col. 7,line 54-Col. 8,

line 22);

and wherein for each of said steps the method generates electronic evaluation

forms, (Abstract, lines 4-14, Figs 10-17);

hierarchically organized as forms and sub-forms, (Col. 11, lines 6-18, from Fig.

10 to Fig. 11);

wherein said evaluation forms comprise a list of recommended actions, (Col. 13,

lines 6-18, Fig. 16);

information-input requests and or/decision-requests, (Col. 13, lines 30-44);

and wherein said generation of evaluation forms is carried out in function of said

hierarchised sequences of alternative actions of said catalogue of recommended

actions, (Col. 3, lines 2-4, Col. 5, lines 21-45);

and in function of the past history of actions,(Col. 6, line 64-Col. 7, line 6);

so as to enable transfer of a group of evaluation forms and sub-forms in one

operation into one file, (Col. 18, line 59-Col. 19, line 8).

As per claim 2, McIlroy, et al discloses:

Wherein said at least one recorded catalogue of recommended actions comprise associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions, (Col. 3, line 2-4).

As per claim 11, McIlroy, et al discloses:

Wherein the steering software is an application embodiment (Col. 5, lines 43-46).

The following is inherent with McIlroy, et al:

LOTUS NOTES and/or LOTUS DOMINO NOTES

because these types of applications are repeatedly used as steering solutions in the electronic document maintenance art. In addition, McIlroy already teaches the use of an application program as steering software as cited above. Limiting these applications to LOTUS NOTES and/or LOTUS DOMINO NOTES does not make the invention patentable.

(11) Response to Argument

Claims 1, 5-10, 12, 16 and 17 stand or fall together as Group 1. Therefore, all responses to arguments applied to claim 1 stands for claims 5-10, 12, 16 and 17. therefore only claim 1 will be addressed in the arguments for Group 1.

As per claim 1, appellant argues that McIlroy et al do not disclose "at least one recorded catalogue of recommended actions" comprised of "hierarchised sequences of alternative actions". First, McIlroy et al discloses the "at least one recorded catalogue of recommended actions" in Col. 7, lines 45-53 which describes a disciplined framework to guide and assist the user. McIlroy et al then discloses that application of a guideline consist of an entry phase, which suggest the "recorded" limitation. In addition, Col. 7,

line 56, where McIlroy et al discloses that the application of a guideline also includes the

assessment phase where treatment options or other actions are identified, along with a

final recommendation phase. In addition, alternative actions are suggested by McIlroy

et al in Col. 8, lines 23-26 where McIlroy et al discloses that more than one treatment

option, an application of a new guideline or the option of further clinical evaluation may

be provided as the outcome of a guideline. In additio   n, in Col. 7, line 54-Col.

8, line 22, McIlroy describes a diagnosis-based guideline that provides the framework to

reflect critical factors in the decision process of the invention. In this description,

specific procedural steps are processed in order to complete the steps of the guideline.

These steps occur in a certain logical sequence with the motivation of providing a

sensible framework and a reasonable diagnosis. The hierarchised sequence comes

into effect when McIlroy et al discloses that questions are presented to the user in a

logically-structured order, leading to guideline treatment option(s) in Col. 3, lines 2-4 or

alternative treatments as disclosed in Col. 5, lines 14-20 with the subclassifications

shown in Col. 9, lines 21-23. Here, McIlroy et al shows that the subclassificaitons are

used to identify severity levels of an illness with asset of treatment options. In addition,

in Col. 5, lines 21-45, the guideline is viewed as a decision tree with multiple data

collection nodes and conditional branching. As described above, in Col. 7, line 56,

McIlroy et al discloses that the application of a guideline also includes the assessment

phase where treatment options or other actions are identified, along with a final

recommendation phase. Therefore, McIlroy suggests that the assessment phase and

final recommendation phase is viewed as a decision tree, which is a hierarchical representation.

Appellant also argues that the algorithm in McIlroy et al is not disclosed as actually coded. However, Col. 7, lines 48-50 of McIlroy et al clearly states that "A guideline is…a definite step by step algorithm that can be coded", which suggests that coding the guideline of the present invention is an inventive option, thereby reinforcing the fact that this guideline is recordable.

Appellant also argues that recommended treatments are only "highlighted" as shown in Col. 12, lines 47-48 and Col. 13, line 1 and are not hierarchical. However, in col. 6, lines 4-6, McIlroy et al discloses that the guideline treatment options are presented and highlighted based on user responses to questions. Since the questions are presented to the user in a hierarchised logically-structured order, as explained above, then one can conclude that the guideline treatment options are presented and highlighted in this order as well.

Appellant also argues that McIlroy et al do not disclose evaluation forms that are hierarchically organized as forms and subforms. However, McIlroy also discloses that for each step, the evaluation forms are generated which are hierarchically organized as forms and sub-forms in Figures 10-17 since the user must make a selection on one screen to go to the next screen. In this case, the first screen would be the top of the hierarchy. Specifically the generation of the sub-form is shown in Figures 10 and 11. In Fig 10, a form is displayed in which the user has the ability to select medical categories in which there are an interest to evaluate. Figure 11 then shows a form where the user

is able to select a guideline by name for a selected category in which there in an interest

to evaluate. In this case, the form in Figure 11 is a sub-form of the form in Figure 10

since the form of Figure 11 comes from the selection made through the form of Figure

10. These forms are hierarchically organized since each form is derived through a

hierarchical process order; the first form in which the user interacts (Fig. 10) is at the

top of the hierarchy and is the form that has the broadest subject matter. The sub-forms

come underneath the form in Fig. 10 and are lower in the hierarchy of forms since they

are derived through selections made in the form. Finally, McIlroy discloses that the

transferring of a group of the evaluation forms and sub-forms using one operation into

one file takes place. This is shown in Col. 18, line 59-Col. 19, line 8. Here, McIlroy

discloses an aggregate report where for each guideline in each category, a aggregate of

the recommendation treatments are disclosed. This operation would be analogous to

aggregating the information taken form the forms and sub-forms since the information

taken from the forms and sub-forms are evaluated and lead to recommendation

treatments. These forms are not only liked, but are embedded as well since a user

must click on an element on one form to get to the next form (Fig. 10 to Fig 11).

Appellant argues that McIlroy et al do not discloses the generation of evaluation

forms for each sequential procedure step of the hierarchised alternative action since,

according to appellant, that the forms generated during the phases in McIlroy et al are

not for each sequential step of a treatment option. However, in Figures 10-12b show

forms that are sequentially generated. Fig. 10 shows a Medical category form. Once

the medical category is selected (Cardiovascular/Respiratory), the next sequential form

is shown in Fig. 11 where a list of Cardiovascular/Respiratory items is listed. Once a specific item from this category is selected, a diagnosis is presented in Fig. 12a, and a treatment is presented in Fig. 12b.

Appellant also argues that McIlroy et al do not disclose the generation of evaluation forms in function of the hierarchised sequences of alternative actions since according to appellant that the questions and answers in the database items in Figs. 2, 4, 5, etc. are not actions. However, in Fig. 5, the database (step 01D) discloses the following action "MEDICATION COURSE CHANGED DUE TO CULTURE RESULTS". Nevertheless, as already described above in the preceding paragraphs, McIlroy et al discloses the generation of evaluation forms in function of the hierarchised sequences of alternative actions. In addition, Fig. 12b shows the generation of a form as a function of a treatment option. In this figure, the treatment options for the Cardiovascular/Respiratory diagnosis are Embolectomy or thrombectomy, vena cava, iliac, or femoropopliteal vein by leg incision. These options are listed due to a selection process demonstrated by the user and are recordable since they are listed on a selection screen, which indicates that they are part of a database. Once the treatment option is selected by the user, as shown in Fig. 16, this is not the endpoint; it is then highlighted. The highlighted treatment option then results in another screen with message lines when selected in Fig. 16 (See bottom of window). This information can be used for further analysis for a final recommendation.

In addition, appellant argues that McIlroy et al do not disclose the generation of evaluation forms in function of the past history of actions since according to appellant,

the question component is not a recorded catalogue of recommended actions and

since, according to appellant, also do not disclose the hierarchised sequences of

alternative actions of the recorded catalogue actions. As described above, McIlroy et al

describes actions in Figure 12b where Embolectomy or thrombectomy, vena cava, iliac,

or femoropopliteal vein by leg incision are recommended actions for the related

diagnosis. In addition, McIlroy et al disclose the hierarchised sequences of alternative

actions of the recorded catalogue actions as described above in the preceding

paragraphs.

Appellant also argues that McIlroy et al fails to disclose the transfer of a group of

evaluation forms and subforms in one operation into one file. However, McIlroy et al

discloses the aggregation of the proposed and final treatment combinations for each

diagnosis. The aggregation of this information is analogous to information from the

forms and subforms being transferred into one file, where the one file is represented by

the aggregation report. In addition, Fig. 16 shows the transfer of the information from

the forms and subforms into one file. At the top of the window, the first category from

the first form in Fig 10 (Cardiovascular/Respiratory) is shown, then the information from

the second form (Fig. 11) is shown (Thrombophelebitis). In the same window, the

treatment recommended is shown (2A, 2B), then at the bottom of the window, the final

recommendation is shown.

Claims 2-3 and 13-14 stand or fall together as Group 2. Therefore, all responses

to arguments applied to claim 2 stands for claims 3, and 13-14 and only claim 2 will be

addressed in the arguments for Group 2.

As per claim 2, the appellant argues that McIlroy et al does not disclose electronic selection algorithms in respect of the hierarchised sequences of alternative actions. However, it is disclosed that the guideline used to derive the assessment and the final recommendation phase is a step-by-step algorithm in Col. 7, lines 45-50. As explained previously, incorporating coded algorithm into the guideline of the present invention is an inventive option, thereby reinforcing the fact that this guideline is recordable. Also as explained previously, the hierarchised sequence comes into effect when McIlroy et al disclose that questions are presented to the user in a logically-structured order, leading to guideline treatment option(s) in Col. 3, lines 2-4 or alternative treatments as disclosed in Col. 5, lines 14-20 with the subclassifications shown in Col. 9, lines 21-23. Here, McIlroy et al show that the subclassificaitons are used to identify severity levels of an illness with asset of treatment options. In addition, in Col. 5, lines 21-45, the guideline is viewed as a decision tree with multiple data collection nodes and conditional branching. As described above, in Col. 7, line 56, McIlroy et al disclose that the application of a guideline also includes the assessment phase where treatment options or other actions are identified, along with a final recommendation phase. Therefore, McIlroy suggest that the assessment phase and final recommendation phase is viewed as a decision tree, which is a hierarchical representation.

As per group 3, the appellant argues that McIlroy do not specifically disclose the use of Louts Notes or Lotus Domino Notes software in claim 11. However, the inclusion of Lotus Notes or Lotus domino Notes software holds no patentable weight to the claim
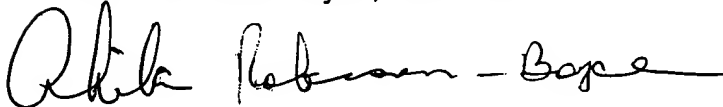
since McIlroy et al incorporates application software into his system which functions as

an interactive presentation tool, permitting the user to interactively exchange information

with the system and is also designed as a shell used to access and present the

guideline content and control the navigation through the questioning process. This

application software is disclosed in Col. 5, lines 42-45 of McIlroy et al. This application

software of McIlroy et al is the steering software of the system.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A. R-B.
December 11, 2003

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